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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/054,597	04/03/1998	JOACHIM POSEGGA	2345/39	2757

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NEW YORK, NY 10004

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 01/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/054,597

Applicant(s)

POSEGGA, JOACHIM

Examiner

Ovidio Escalante

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on November 9, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/054,597 is acceptable and a CPA has been established. An action on the CPA follows.

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### *Claim Rejections - 35 USC § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 5, 7, 10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Moss et al. U.S. Patent 5,485,370 (hereinafter Moss), as used in the previous Office Action.

**Regarding claim 1**, Moss discloses of an apparatus (user terminal 1,19 and network server 60) for using a service made available in a telecommunications network (Moss discloses e.g. of the service being a financial service which is made available to the user), the apparatus comprising:

at least one network server (60) having a user interface program, (col. 18 lines 33 – 41), (The network server, which is the host computer, has series of application programs for use by a terminal (telephone-computer 1 or PC terminal 19));

a user-side terminal (1 – Fig. 10), the user side terminal being capable of connection to the at least one network server, (Fig. 10, col. 9, lines 21-25), (The user may connect and communicate to the network server via conventional telephone lines as shown);

a control and operating device (19) executing a user interface to control and operate the service, (col. 18 lines 54 – 60), (the user terminal will operate the program (service) that was downloaded from the network server by providing instructions to the user);

wherein the control and operating device is assigned to the user-side terminal (telephone-computer) and the at least one network server transmits (downloads) the user interface program to the control and operating device before service is used, (col. 3 lines 48 – 53 and col. 12 lines 45 – 61), (the network periodically downloads new services to the terminal before the user uses the service so that the user will always have the must current service program).

**Regarding claim 2**, the user side terminal includes a telephone (1), (Fig. 1).

**Regarding claim 5**, Moss teaches of the microphone in the telephone being used for inputting speech and the control and operating device is used for displaying text, (col. 4 lines 44 – 46, 60 – 62).

**Regarding claim 7**, the control and operating device includes a computer (19), (Fig. 1).

**Regarding claim 10**, Moss discloses of a method using a service made available in a telecommunications network wherein at least one network server stores at least one user interface program, (col. 18 lines 21 – 41), the at least one user interface program providing operating functionality, said method comprising:

using a user-side control and operating device (19) to request the at least one user interface program to be transmitted from the at least one network server to the control and operating device before the service is used, (col. 3 lines 48 – 53 and col. 12 lines 45 – 61); and  
executing the user interface program by the control and operating device, so that an operator can control and operate the service through a user interface, (col. 5 lines 7 – 38).

**Regarding claims 15**, Moss discloses of an apparatus (network host, user terminal) for using a service in a telecommunication network, the apparatus comprising:

means for providing at least one user interface providing an operating functionality, (col. 18, lines 49-55), (The network server provides a user interface program which is operable on the user terminal);

means for serving a network and for storing at least one user-interface, (col. 18, lines 49-55), (The network host will retrieve the user interface from the internal memory);

means for requesting transmission of the at least one user-interface to the means for requesting, before the service is used, (col. 18, lines 44-50), (When the user request a user the network host will transmit the user the requested service); and

means for executing the at least one user interface so that the service is controllable and operable by the user through the at least one user interface, (col. 18, lines 54-60).

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 3-4, 6, 8-9, 11-14, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss in view of Dekelbaum U.S. Patent 5,838,682.

***Regarding claims 3***, Moss, as applied above, does not expressly teach of the service including a speech recognition system.

Dekelbaum teaches of a system which provides Internet applications to the user. Dekelbaum further teaches of the system comprises of a speech recognition system, (col. 14 lines 38 – 40). The system receives user inputs from the user telephone and uses the user's speech for playback to an operator or to send to a speech recognition system to input the speech from the user onto the screen for display to an operator. All user inputs whether by DTMF or speech is sent to the operator workstation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using speech recognition in the system as taught by Dekelbaum so that the system can display speech in the form of text to the user.

**Regarding claim 4**, Moss, as applied above, teaches of connecting to the network server via a conventional telephone line. Moss does not expressly teach of the apparatus comprising an ISDN line connected to the at least one network server.

Dekelbaum teaches connecting to the network server a via an ISDN connection. Dekelbaum further teaches a first channel of the ISDN line being assigned to the user side terminal and a second channel of the ISDN line being assigned to the control and operating device, (col. 6, lines 44 – 62, col. 14, lines 58 – 61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using and ISDN connection as taught by Dekelbaum so that there can be a faster connection and data speed, between the user device and network server.

**Regarding claims 6, 8, 9, 11, 13 and 20**, Moss does not expressly teach of the control and operating device or the terminal including a JAVA processor or a JAVA execution-time environment.

Dekelbaum teaches of using JAVA in the system, (col. 12 lines 35 – 36). JAVA is used for sending to the user applets with the program.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using JAVA so that programs can be left on web pages which will allow the programs to be downloaded over the Internet.

**Regarding claim 12**, Moss, as applied to claim 11, does not expressly teach of the service providing processing of speech into text.

Dekelbaum teaches of speech-to-text conversion and the display of the text being carried out using the control and operating device and conversion of speech into text being carried out by the at least one network server, (col. 14, lines 32 – 48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using speech recognition in the system as taught by Dekelbaum so that the system can display speech in the form of text to the user.

***Regarding claims 14, 16 and 17,*** Moss does not teaches of the user interface program being transmitted as a JAVA applet or of speech to text conversions, as applied above.

Dekelbaum teaches of transmitting user programs as JAVA applets, (col. 12, lines 35 – 36). Dekelbaum further teaches of speech-to-text conversion and the display of the text being carried out using the control and operating device and conversion of speech into text being carried out by the at least one network server, (col. 14, lines 32 – 48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by providing JAVA applets so that the network server can send programs to the user through the Internet and it would have been obvious to further modify the system by providing speech to text conversions so that the user responses via the user terminal can be displayed on a terminal screen.

***Regarding claim 18,*** Dekelbaum teaches of a system which comprises of a speech recognition system, (col. 14, lines 38 – 40). The system receives user inputs from the user telephone and uses the user's speech for playback to an operator or to send to a speech recognition system to input the speech from the user onto the screen for display to an operator.



Dekelbaum further teaches of a first channel of the ISDN line being assigned to the user side terminal and a second channel of the ISDN line being assigned to the control and operating device, (col. 6, lines 44 – 62, col. 14, lines 58 – 61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moss by using an ISDN connection as taught by Dekelbaum so that there can be a faster connection and data speed, between the user device and network server.

**Regarding claim 19**, Moss teaches of a telephone including a microphone for inputting speech and the control and operation device including a computer to display text, (col. 18, lines 49-51). Also the Examiner notes that a telephone inherently has a microphone for inputting speech and the control and operating device displays to the user the interface program.

#### ***Response to Arguments***

6. The Examiner would like to verify that claims 1-20 are pending. The Applicants state that claims 1 to 21 are now pending, (page 3, line 1 of the Remarks. **Presumably** this is a typographical error. If this is not so, then the Examiner respectfully asks to make the appropriate addition on a subsequent response.

7. Applicant's arguments filed April 09, 2001 have been fully considered but they are not persuasive.

The Applicant states that “any review of the Moss reference makes plain that it simply does not in any way identically disclose or suggest of an apparatus that includes a (i) “*control and operating device executing a user interface to control and operate the service*”, in which the (ii) “*control and operating device is assigned to the user-side terminal*” and in which (iii) “*at*

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*least one network server transmits the user interface program to the control and operating device before the service is used*". The Examiner respectfully disagrees for the following reasons.

(i) The control and operating device, which is the user terminal i.e., computer-telephone 3,19 as shown in figure 10, provides a user interface to the user. The user interface is a program that is downloaded from the network server (60). The user terminal controls and operates the service by asking the user various questions for accessing the financial service.

(ii) Since the terminal is at the user premise inherently it is assigned to the user.

(iii) Updated versions of services are downloaded to the user terminal every time they connect to the network server if it is determined that there is a newer version of the program that what is being used by the terminal. Therefore the service is downloaded to the user before the user can use the service.

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the secondary reference Deklbaum which has a user side terminal (8a) and which operates a service (the service is provided through the Internet to the user) establishes a connection to a network service provider (service representative). The network server provides and downloads to the user various user-interfaces (web pages) that are requested from the user.

The Examiner believed that one of ordinary skilled in the art would have been able to modify Moss in view of Deklbaum such that the modified system of Moss performs at least:

- i) connect to a network server via an ISDN line;
- ii) having a JAVA processor; and
- iii) using speech-to-text conversions.

As stated in the Final Office Action it would have been obvious to us an ISDN line instead of a conventional telephone line so that a faster connection speed between the user terminal and network server may be used. The use of ISDN lines is also old and well known in the art. The Examiner provides motivation and obviousness for the other two combinations. Therefore proper obviousness was presented to the Applicant.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Examiner presented to the Applicant motivations that would have been obvious to a person of ordinary skilled in the art in the Final Office Action above. As stated above the use of ISDN, JAVA processor and speech-to-text conversions are old and well known in the art.

### *Conclusion*

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 308-6306 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington, VA, Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262.  
The examiner can normally be reached on Monday to Friday from 7:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group  
is (703) 308-6306 or (703) 308-6296.

Communications via Internet e-mail regarding this application, other than those under 35  
U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be  
addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO  
employees do not engage in Internet communications where there exists a possibility that  
sensitive information could be identified or exchanged unless the record includes a properly

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signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Ovidio Escalante  
Examiner  
Group 2645  
January 15, 2002

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

